REMARKS

Claims 1-18 and 22-83 remain pending in the application.

In the Office Action, the pending claims have been rejected as allegedly being obvious and unpatentable under 35 U.S.C. § 103(a) based on a number of grounds. As set forth in detail below, Applicants respectfully submit that these rejections are in error and should be withdrawn.

A. Rejections in view of U.S. Patent No. 4,173,627 (hereinafter "Madrange")

The Office Action has rejected Claims 1-18, 22-32, 36-53, 57-59, 61-62 and 73-83 as allegedly being obvious and unpatentable over the disclosure of Madrange alone and, alternatively, over the disclosure of Madrange further in view of Japanese Patent Abstract JP 08187277 (hereinafter "JP '277"). To that end, it is well established in law that to present a *prima facie* case of obviousness an Examiner is burdened with showing the art relied upon in the rejection teaches, or at least suggests, the claimed invention as a whole. Moreover, the Examiner must also identify the adequate motivation and a reasonable expectation of success for one of ordinary skill in the art to undertake the modifications proposed in the rejection. For the reasons set forth below, Applicants respectfully submit that the instant rejections fail to satisfy these requirements.

As previously presented, Applicants' independent claims 1 and 80 each recite a composition comprising, in part, at least 10% by weight methyl acetate and 20% to 55% by weight of an alkanol component comprising ethanol. Neither Madrange nor JP '277, alone or in any combination, teach or even suggest this combination much less provide the requisite motivation and expectation of success required to support these rejections.

As acknowledged by the Examiner throughout the course of this prosecution, Madrange fails to explicitly teach any combination of methyl acetate and ethanol. In view of this deficiency, the Examiner previously sought guidance from the teachings of JP '277 to support the contention

that the claimed combination would have been obvious to one of ordinary skill in the art at the time of the invention. However, for reasons unbeknownst to Applicants and unsupported in the instant rejection, the Examiner has now broadened the grounds of rejection by contending that Madrange alone provides sufficient guidance for one of ordinary skill in the art to arrive at the claimed combination of methyl acetate and ethanol. This simply is incorrect.

Madrange discloses a hair care composition containing at least one of: (a) a lower alkanol, such as ethanol, propanol, isopropanol or butanol; (b) a solvent such as 1,1,1-trichloroethane and methylene chloride; and (c) a diluent such as a ketone, in particular acetone and methylethyl ketone; an alkyl acetate, in particular methyl acetate or ethyl acetate, or a hydrocarbon, in particular a C_3-C_7 alkane. Although at least one of the three components (a), (b), or (c) is present in the composition, Madrange makes clear that none of components (a), (b) or (c) is required. *See* Col. 3, lines 48-52. Furthermore, although Madrange does disclose ethanol and methyl acetate individually, as admitted by the Examiner, it does not teach or suggest the claimed combination of ethanol and methyl acetate.

In support of the rejection, the Examiner relies upon Example 1 of Madrange which discloses an exemplary composition comprised of isobutane and ethanol. In particular, the Examiner suggests it would have been obvious for one of ordinary skill in the art to substitute methyl acetate for the isobutene component because Madrange teaches generally that the diluent can also be methyl acetate. Notably absent from this rejection however is the identification of a suggestion, teaching or motivation that would lead one of ordinary skill in the art to actually make the Examiner's proposed substitution. To that end, Applicants do not dispute that Madrange discloses methyl acetate as a possible diluent. What Madrange fails to teach or suggest and therefore the Examiner has failed to establish, is not whether methyl acetate can be used but rather, whether the claimed combination of methyl acetate and ethanol can be used.

The Examiner further relies upon M.P.E.P. section 2123 for the premise that "Patents are Relevant as Prior Art for All They Contain." However, this section is not a license to merely

extract two components, namely "methyl acetate" and "ethanol," from a plethora of possible ingredients and combinations and then suggest they could be combined in a first step toward solving the problem identified by Applicants. In fact, to modify a prior art reference without evidence of such suggestion, teaching or motivation is an impermissible hindsight reconstruction and simply takes the inventor's own disclosure as a blueprint for piecing together the prior art in an effort to defeat patentability. Thus, the motivation to modify the teaching of a reference cannot come from the Applicants' own invention. Simply put, there is no teaching or suggestion in Madrange that would motivate one of ordinary skill in the art to arrive at a hair care composition comprising the claimed combination of methyl acetate and ethanol and, as such, any rejection of the instant claims in view of Madrange should be withdrawn.

In an alternative rejection, Claims 1-18, 22-32, 36-53, 57-59, 61-62, and 73-83 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Mandrange in view of JP 08187277 (hereinafter "JP '277"). In particular, the Examiner contends that it would have been obvious for the skilled artisan to utilize the combination of methyl acetate and ethanol in the composition of Madrange because JP '277 teaches that methyl acetate can mask the odor of lower alcohols in a cosmetic composition. To that end, even assuming *arguendo* that one of skill in the art would have combined the disclosures of Madrange and JP '277 as proposed in the instant rejection, the combined teachings fail to arrive at the composition recited in the instant claims wherein the methyl acetate is present in an amount of at least 10 weight percent of the composition.

JP '277 discloses the use of methyl acetate as a masking agent to mask the allegedly irritating odor of an alcohol component in cosmetic compositions. In particular, JP '277 specifically states that "the concentration of the masking agent capable of effectively exhibiting the action is 0.1-10 wt.%, more preferably 0.5-5 wt.% based on the alcohol." Thus, JP '277 teaches that the effective amount of methyl acetate set forth above is determined relative to the weight of the alcohol component alone and not relative to the total weight of the composition. Furthermore, JP '277 also states that the solvent effect of the lower alcohol component may be

compromised if the amount of the masking agent exceeds 10 wt% and therefore teaches away from using methyl acetate in any amount exceeding 10 wt% relative to the weight of an alcohol component. Since Applicants' independent Claims 1 and 80 recite compositions comprising 20 wt% to 55 wt% of an alkanol component, the guidance of JP '277 teaches that the highest concentration of methyl acetate that could effectively be used would be 5.5 wt% of the total composition (10 % of the 20 wt% to 55 wt% alkanol component). Therefore, even if one of ordinary skill in the art would have combined these teachings as proposed in the rejection, the result would not provide a composition wherein 10 wt% of the composition is methyl acetate as set forth in the instant claims.

In view of the specific limitations on the amount of methyl acetate that JP '277 suggests can be used, the Examiner states that JP '277 is only relied upon for the specific motivation to combine methyl acetate with ethanol in a cosmetic composition and is not relied upon for the weight percentage limitations disclosed therein. This however constitutes an improper selective reading of the reference. It is improper to pick and choose from any one reference only so much of it that will support a given position without addressing the full appreciation of what the reference would suggest to one of ordinary skill in the art. *In re Wesslau*, 353 F.2d 238, 240, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965). Therefore, if the Examiner intends to rely upon a reference such as JP '277 for its alleged teaching of methyl acetate in combination with ethanol, the Examiner must view that specific teaching in the context of the reference as a whole. As set forth above, JP '277 explicitly states that the amount of methyl acetate masking agent that can be used to mask the odor of an alcohol in a cosmetic composition should not exceed 10 weight percent of the alcohol component. This specific amount is significantly less than the amount recited in the instant claims, *i.e.*, 10 weight percent of the total composition. To intentionally ignore this specific teaching away from the claimed amount of methyl acetate, as the instant rejection purports to do, is evidence of an improper hindsight rejection.

Still further, the Office Action has also rejected several additional dependent claims on a number of grounds. Specifically, Claims 33-35, 56, 60 and 63-72 have been rejected under 35

U.S.C. § 103 over Madrange in view of JP 08187277, in further view of Chaung. Also, Claims 54 and 55 have been rejected under 35 U.S.C. § 103 over Madrange in view of JP 08187277, in further view of Morawsky. To that end, it is axiomatic that dependent claims are non-obvious under section 103 if the independent claims from which they depend are non-obvious. See *In re Fine,* 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988). Thus, while Applicants do not concede or agree with these rejections, Applicants need not address the substantive merits of these rejections in detail because the teachings of Madrange alone, and further in view of JP 08187277, are insufficient to defeat the patentability of independent Claims 1 and 80 as discussed above. Accordingly, it is respectfully submitted that dependent Claims 33-35, 54-56, 60 and 63-72 are also allowable over the instant rejections.

B. Rejections in view of U.S. Patent No. 4,243,548 (hereinafter "Heeb")

The Examiner has again rejected Claims 1-18, 27-51, 56-57, 61-68 and 76-83 under 35 U.S.C. §103(a), as allegedly being unpatentable over U.S. 4,243,548, Heeb *et al.*, (hereinafter "Heeb") in view of JP '277. In particular, the Examiner continues to acknowledge that Heeb fails to teach the claimed combination of ethanol and methyl acetate and thus relies upon the disclosure of JP '277 for its specific teaching of a composition comprising both methyl acetate and ethanol as co-solvents. For the reasons set forth below, Applicants respectfully submit that this proposed combination still fails to provide the claimed compositions.

As detailed above, JP '277 specifically teaches that the concentration of methyl acetate that can be used in combination with an alcohol is 0.1-10 wt. % and more preferably 0.5-5 wt. %, based upon on the amount of alcohol present in the composition. Thus, JP '277 teaches that the effective amount of methyl acetate set forth above is determined relative to the weight of the alcohol component alone and not relative to the total weight of the composition. Furthermore, JP '277 also states that the solvent effect of the lower alcohol component may be compromised if the amount of the methyl acetate exceeds 10 wt% and therefore teaches away from using methyl acetate in any amount exceeding 10 wt% relative to the weight of an alcohol component. Thus, following the guidance of JP '277, the highest concentration of methyl acetate that could

effectively be used in the Applicant's composition would be 5.5 wt% of the total composition (10 % of the 20 wt% to 55 wt% alkanol component) and not 10 weight percent as suggested in the rejection. Therefore, even if one of ordinary skill in the art would have combined these teachings as proposed in the rejection, the result would not provide a composition wherein 10 wt% of the composition is methyl acetate as set forth in the instant claims.

Applicants would again note that any reliance upon JP '277 for its alleged teaching of methyl acetate in combination with ethanol must view that specific teaching in the context of the reference as a whole. The Examiner cannot properly select only those portions of a reference that will support a given position without addressing the full appreciation of what the reference would suggest to one of ordinary skill in the art. Therefore, if one of ordinary skill in the art were to seek the guidance of JP '277 for the combination of methyl acetate and alcohol as suggested in the rejection, the skilled artisan would only have been motivated to use the methyl acetate in the manner and amount described therein. To that end, JP '277 explicitly teaches a maximum amount of methyl acetate that can be used in combination with an alcohol without compromising the solvent effect of the alcohol. This specified amount does not exceed 10 weight percent relative to the amount of alcohol and is significantly less than the amount recited in the instant claims, *i.e.*, 10 weight percent of the total composition. Therefore, for at least this reason, the combined teachings of Heeb and JP '277 do not render the compositions of Applicants' claims obvious and the instant rejections should be withdrawn.

CONCLUSION

In view of the Remarks set out above, it is respectfully asserted that the rejections set forth in the Office Action of February 21, 2007 have been overcome and that the application is now in condition for allowance. Accordingly, Applicants respectfully seek notification of same.

Respectfully submitted,

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/Brian C. Meadows/ — August 21, 2007

Brian C. Meadows — Date